

REMARKS

The Final Office Action of March 22, 2006, has been considered by the Applicants. No claims have been amended. Claims 1-32 are pending. Reconsideration of the Application is requested.

In the Office Action, the rejection of claims 1-12, 16, 17, 19-27, and 30-32 over Fuller and Deubzer was maintained. Additionally, the rejection of claims 1-14, 16, 17, 19-22, and 28-32 over Fuller and Pinschmidt, Jr. was maintained. Applicants traverse these rejections together.

Applicants previously argued that there was no motivation to combine because Fuller does not teach the hydrolysis is performed in the presence of a "basic catalyst". The Examiner has replied that although Fuller does not specifically teach a basic catalyst, he does use a catalyst known to function in a hydrolysis action. Because there are other catalysts known and used in a hydrolysis reaction, the skilled artisan would be motivated to use a basic catalyst, as taught by the secondary references, to increase the yield of the desired product.

Applicants believe the Examiner is stating that any catalyst known to function in a hydrolysis action, acidic or basic, may be used. If this is the case, there is no motivation to combine the references. In particular, neither Deubzer nor Pinschmidt, Jr. make any teaching that suggest that using a basic catalyst will increase the yield of the desired product over the BTHF catalyst used in Fuller. This is the appropriate test because all of the teachings Fuller makes must be considered and he teaches the use of BTHF. MPEP § 2141. The mere fact that the references can be combined is not sufficient to establish obviousness. MPEP § 2143.01(III). Applicants note that Deubzer prefers basic catalysts that are aminosilanes. However, the reason Deubzer prefers basic catalysts is because the aminosilanes can be incorporated into the organopolysiloxane shell of his invention. See col. 4, lines 25-41. This reason does not apply to the instant claims. Pinschmidt, Jr. only lists acidic and basic catalysts; he gives no reason for preferring one over the other. See col. 8, lines 23-28.

Applicants also take the position that BTHF is an acid catalyst. Therefore, Fuller teaches away from using a basic catalyst. MPEP § 2145(X)(D).

Applicants previously argued that the Examiner used improper hindsight argument; see MPEP § 2145(X)(A). The Examiner has still not explained how the references teach that a basic catalyst is suitable for use in forming poly(vinylbenzyl alcohol).

For these reasons, Applicants request withdrawal of the rejections based on Fuller combined with either Deubzer or Pinschmidt, Jr.

Claims 1-14, 16, 17, 19-22, and 28-32 were rejected under U.S.C. 103(a) as unpatentable over Fuller in view of Sato (5,710,211). Applicants traverse the rejection.

In the prior Amendment filed January 9, 2006, Applicants made specific arguments directed to this rejection. The Examiner has not responded these arguments.

The Examiner previously stated that Sato is relied upon simply for its teaching of solvents (i.e. pyridine) suitable for use in similar reactions. Sato does not teach the use of pyridine as a solvent; he teaches the use of pyridine as a catalyst between two specific reactants. Neither reactant is similar to poly(vinylbenzyl acetate) and the Examiner has not shown where Fuller or Sato explains how a catalyst suitable for those reactants is suitable for poly(vinylbenzyl acetate). Also, a solvent and a catalyst perform different functions and the recitation of pyridine as a catalyst would not suggest its use as a solvent to one of ordinary skill in the art. Therefore, the combination of Fuller and Sato would not render obvious the instant claims.

For these reasons, Applicants request withdrawal of the rejection based on Fuller combined with Sato.

CONCLUSION

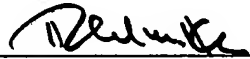
For the reasons given above, Applicants submit the pending claims (1, 3-16, and 18-32) are in condition for allowance. Withdrawal of the rejections and issuance of a Notice of Allowance is requested.

In the event the Examiner considers personal contact advantageous to the disposition of this case, she is hereby authorized to call Richard M. Klein, at telephone number 216-861-5582, Cleveland, OH.

It is believed that no fee is due in conjunction with this response. If, however, it is determined that fees are due, authorization is hereby given for deduction of those fees, other than the issue fees, from Deposit Account No. 24-0037.

Respectfully submitted,

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